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| 10/817,126 | 04/02/2004 | Miles Libbey | 08226/1200320-US1 | 1506 |
| 38880 | 7590 | 08/07/2008 | EXAMINER | |
| Yahoo! Inc. c/o DARBY & DARBY P.C. P.O. BOX 770 Church Street Station NEW YORK, NY 10008-0770 | | | NGUYEN, DUSTIN | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/817,126

Applicant(s)

LIBBEY ET AL.

Examiner

DUSTIN NGUYEN

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-30 are presented for examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/23/2008 has been entered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 30 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 30 is directed to a computer readable medium wherein the computer readable medium, according to the disclosure, page 6, lines 5-17, also includes data signal such as carrier wave. Applicant has provided evident that Applicant intends the medium to include signals as such the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim is not statutory. Energy is not a series of steps or

acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not combination of substances and therefore not a composition of matter. Therefore, the claim is rejected under 35 U.S.C. §101 rejection as directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5, 7, 9-14, 16, 18-23, 25, and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al. [US Patent No 7,380,126], in view of Rhodes [US Patent Application No 2003/0220978].

6. As per claim 1, Logan discloses the invention as claimed including a method for managing outbound message usage [i.e. controlling the transmission of email messages] [Figure 1; and Abstract], comprising:

determining a count of each recipient for each outbound message associated with a client [i.e. count recipients] [115, Figure 1; col 3, lines 44-50; and col 4, lines 12-21]; if the count of each recipient is at least equal to a limit over at least one period of time [i.e. exceeds a threshold] [117, Figure 1; col 3, lines 49-51; and col 4, lines 12-21], providing a visual

challenge to the client [i.e. notify sender with warning message] [118, Figure 1; and col 3, lines 51-57], wherein the client's outbound message usage includes a message composed by the client before the providing of the visual challenge to the client [i.e. compose email message] [111, Figure 1; col 3, lines 10-21; and col 4, lines 34-37].

Logan does not specifically disclose

if the provided visual challenge is unresolved, disabling the client's outbound message usage until the visual challenge is resolved, wherein disabling the client's outbound message usage occurs prior to sending the compose message for the client over a network from a messaging system employed to originate each outbound message associated with the client.

Rhodes discloses

if the provided visual challenge is unresolved, disabling the client's outbound message usage until the visual challenge is resolved [i.e. interrupt or postpone delivery of email message until the message sender passes a user-configurable challenge] [Abstract; paragraphs 0014 and 0026], wherein disabling the client's outbound message usage occurs prior to sending the compose message for the client over a network from a messaging system employed to originate each outbound message associated with the client [i.e. postpone to forwarding of the received e-mail message to the recipient until after an acceptable response to the challenge message has been received] [Abstract; paragraphs 0034 and 0037; and claim 2].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Logan and Rhodes because the teaching of challenge-response in Rhodes would enable to implement a challenge protocol to qualify e-mail senders before delivery of e-mail messages [Rhodes, paragraph 0014].

7. As per claim 2, Logan discloses if at least one outbound message associated with the client is indicative of spam for at least one recipient, providing the visual challenge to the client [i.e. spam email] [col 1, lines 47-col 2, lines 17; and col 4, lines 12-21].

8. As per claim 3, Rhodes discloses wherein the visual challenge further comprises an auditory challenge, and wherein until at least one of the visual challenge and the auditory challenge is resolved, disabling the client's outbound message usage [paragraphs 0026, 0043, and 0044].

9. As per claim 5, Rhodes discloses wherein the visual challenge further comprises an auditory challenge, and wherein the auditory challenge includes at least one sound clip that is filtered to distort the playing of the sound clip for the auditory challenge [paragraphs 0026, 0044; and claim 14].

10. As per claim 7, Rhodes discloses if the provided visual challenge is unresolved over a predetermined period of time, disabling the client's outbound message usage [i.e. wait for satisfactory response] [paragraphs 0034, 0037 and 0061].

11. As per claim 9, Logan discloses wherein a type of the message includes at least one type of email, blog, message board, Short Message Service (SMS), Multi-Media Message Service (MMS), and instant messaging (IM) [Abstract; and col 1, lines 56-65].

12. As per claim 10, Rhodes discloses if the client's outbound message usage is disabled, providing instructions for an out of band communication by the client for re-enabling the client's outbound message usage [i.e. generate challenge until receive satisfactory response] [paragraphs 0034 and 0037].
13. As per claim 11, Logan discloses employing a recipient count statement to determine the count for each recipient for each outbound message associated with the client, wherein the recipient count statement determines at least one of a current hour recipient count, a current daily recipient count, and a total recipient count [i.e. an indication of the number of other recipients] [col 1, lines 59-61; and col 3, lines 64-67].
14. As per claims 12-14, 16, and 18-20, they are rejected for similar reasons as stated above in claims 1-3, 7, 9-11.
15. As per claims 21-23, 25, 27-29, they are rejected for similar reasons as stated above in claims 1-3, 7, 9-11.
16. As per claim 30, it is rejected for similar reasons as stated above in claim 1.

17. Claims 6, 8, 15, 17, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al. [US Patent No 7,380,126], in view of Rhodes [US Patent Application No 2003/0220978], and further in view of Wilson [US Patent Application No 2004/0015554].

18. As per claim 6, Logan and Rhodes do not specifically disclose determining another count for each attempt to resolve the visual challenge; and if the other count for each attempt is at least equal to another limit, disabling the client's outbound message usage. Wilson discloses determining another count for each attempt to resolve the visual challenge; and if the other count for each attempt is at least equal to another limit, disabling the client's outbound message usage [i.e. allow another try if response is not correct] [Figure 2; and paragraphs 0063 and 0065]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Logan, Rhodes and Wilson because the teaching of challenge-response in Wilson would provide a mechanism for eliminating or at least greatly reducing the successful transmission of unwanted e-mail while still making it easy and convenient to receive wanted e-mail [Wilson, paragraphs 0002 and 0022].

19. As per claim 8, Wilson discloses if the visual challenge is resolved, resetting the count for each recipient of each outbound message associated with the client [paragraphs 0063 and 0072].

20. As per claims 15 and 17, they are rejected for similar reasons as stated above in claims 6 and 8.

21. As per claims 24 and 26, they are rejected for similar reasons as stated above in claims 6 and 8.
22. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al. [US Patent No 7,380,126], in view of Rhodes [US Patent Application No 2003/0220978], and further in view of Burrows et al. [US Patent No 7,149,801].
23. As per claim 4, Logan and Rhodes do not specifically disclose wherein the visual challenge includes at least one Captcha test. Burrows discloses wherein the visual challenge includes at least one Captcha test [col 3, lines 19-25; and col 25, lines 36-46]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Logan, Rhodes and Burrows because the teaching of Burrows would enable to create puzzles that can be solved only by humans, for the purpose of telling humans and computers apart over a network [Burrows, col 3, lines 19-21].
24. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

25. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Dustin Nguyen/
Primary Examiner, Art Unit 2154